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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,869	04/16/2004	Ricardo Alexander Gomez	5285-0002	9828
35301 7590 03/10/2010 MCCORMICK, PAULDING & HUBER LLP CITY PLACE II 185 ASYLUM STREET HARTFORD, CT 06103				
EXAMINER				
KASZTEJNA, MATTHEW JOHN				
ART UNIT		PAPER NUMBER		
3739				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/826,869

Applicant(s)

GOMEZ, RICARDO ALEXANDER

Examiner

MATTHEW J. KASZTEJNA

Art Unit

3739

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 42 and 43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 43 is/are allowed.
- 6) ☒ Claim(s) 1-15 and 42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 May 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ ~~Notice of Informal Patent Application~~
- 6) ☐ Other: _____

DETAILED ACTION

Notice of Amendment

In response to the amendment filed on November 20, 2009, new claim 43 is acknowledged. The current rejections of the claims *stand*. The following new and reiterated grounds of rejection are set forth:

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "vents", "self-sealing mechanism", "first inner chamber", "second inner chamber", "solid flap", "hinge-like connection", "plunger cylinder", "sponge", "vent cover" and a "protective cover" (all recited in new claim 43) all must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 10-15 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication 2002/0022762 to Beane et al.

In regards to claim 1, Beane et al disclose a sterile apparatus to protect endoscopes comprising: an impact resistant housing 110 having an outer surface defining an opening 140, an interior of the housing defining a canal 114 having a first end 122 communicating with the opening and a second end 124 terminating (canal terminates via distal end 124 attached to bottle 118) within the housing for receiving a distal lens 14 of an endoscope 10 (see Figs. 2a-c); a defogging material 116/118 disposed adjacent to the second end of the canal for defogging a distal lens of an endoscope when inserted within the canal (see paragraph 0056). In the embodiment shown in Figures 2a-f, Beane et al. are silent with respect to a self-sealing mechanism disposed within the canal, the self-sealing mechanism being configured to allow for an endoscope to enter the canal and make contact with the defogging material and to

prevent the defogging material from spilling out of the canal. However, as seen in Figs 6a-b, Beane et al. teach of an embodiment wherein a proximal region 612 includes a *distal seal 620* and a *proximal seal 622*. Distal seal 620 has a generally conical shape, and is oriented to remove fluid from shaft 12 of laparoscope 10 as laparoscope 10 is moved in the direction of arrow G. Proximal seal 622 has a generally circular shape, and acts to remove fluid and debris from shaft 12 as it is moved in the direction of either arrow F or arrow G. Proximal seal 622 can be, e.g., an O-ring. Seals 620 and 622 can be made from, e.g., silicone or various thermal-plastic rubbers (see paragraphs 0089-0090). The seals would also effectively remove any excess cleaning liquid deposited on the lens from sponge 116, upon removal of the endoscope from canal 114. Thus, Beane et al. demonstrate that one skilled in the art at the time the invention was made, would have been motivated to position a self-sealing mechanism(s) at the entrance end of the canal and/or within the canal in the disclosed first embodiment to effectively remove any fluid or debris from the distal lens 14 of the endoscope as it is inserted into the canal 114.

In regards to claims 2 and 4, Beane et al disclose a sterile apparatus to protect endoscopes, wherein the canal is shaped for receiving a plurality of types of endoscopes (see paragraph 002). Beane et al. teach that the dimensions of different components in device 110 can be altered to accommodate different types of optical surgical instruments. For example, opening 140, bore 142, and tube 114 need not be cylindrical. The dimensions can also be adjusted to accommodate optical surgical

instruments other than those used in minimally invasive procedures (see paragraph 0062).

In regards to claim 3, Beane et al disclose a sterile apparatus to protect endoscopes, wherein the apparatus is made of disposable material as it is well-known that all materials regardless of composition are capable of being disposed.

In regards to claim 5, Beane et al disclose a sterile apparatus to protect endoscopes, wherein the apparatus is configured to protect endoscopes during intermittent use (see paragraph 0016).

In regards to claim 6, Beane et al disclose a sterile apparatus to protect endoscopes, wherein the apparatus is inherently configured to protect endoscopes during transportation (see Fig. 2a).

In regards to claim 7, Beane et al disclose a sterile apparatus to protect endoscopes, wherein the interior of the housing includes: a storage sheath 114 defining the canal, the outer surface of the housing and the storage sheath defining a cavity therebetween; and an impact absorbing material 120 substantially filling the cavity (see Figs. 2a-c and paragraph 0059).

In regards to claim 10, Beane et al disclose a sterile apparatus to protect endoscopes, wherein the impact absorbing material is a liquid (see paragraphs 0057-0058).

In regards to claim 11, Beane et al disclose a sterile apparatus to protect endoscopes, wherein the impact absorbing material is a gas (see paragraphs 0057-0058 and 0060). As broadly, as claimed, the air environment within the housing may be

interpreted as an impact absorbing material. Furthermore, the heating pad includes a chemical mixture which when activated produces gases.

In regards to claims 12-15, Beane et al disclose a sterile apparatus to protect endoscopes, further comprising an anchor 162 and a cord 164 attached to the housing and the anchor, to be used for a means for removable affixing the housing to a surface (see Figs. 2d-e and paragraph 0066).

In regards to claim 42, Beane et al disclose a sterile apparatus to protect endoscopes, further comprising a reservoir 118 for communicating with the second end of the canal for accommodating the defogging material (see Fig. 2a and paragraphs 0012 and 0053)

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication 2002/0022762 to Beane et al. in view of Dohm et al. (U.S. Patent No. 5,720,391).

In regard to claim 8, Beane et al. disclose a sterile apparatus to protect endoscopes (see rejection above) but are silent with respect to wherein the impact absorbing material is Styrofoam. However, Dohm et al. teach a similar transportation case for a medical instrument having a spacer 212 made of shock absorbing material, such as a Styrofoam material (see col. 5, lines 64-66). Dohm et al. thus demonstrate that the use of Styrofoam materials for cushioning a medical device during transport is well known in the art. Accordingly, it would have been obvious for one of ordinary skill in the art at the time the invention was made to utilize Styrofoam in the apparatus of Beane et al. as an alternate means for cushioning the endoscope.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication 2002/0022762 to Beane et al. in view of Lantz (U.S. Patent No. 6,910,582).

In regard to claim 9, Beane et al. disclose a sterile apparatus to protect endoscopes (see rejection above) but are silent with respect to wherein the impact absorbing material is a gel. However, Lantz teaches a similar transportation case having a gel pack 40 for cushioning (see col. 5, lines 55-65). Lantz thus demonstrates that the use of gel materials for cushioning is well known in the art. Accordingly, it would have been obvious for one of ordinary skill in the art at the time the invention was made to utilize a gel in the apparatus of Beane et al. as an alternate means for cushioning the endoscope.

Allowable Subject Matter

Claim 45 is allowed. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Response to Arguments

Applicant's arguments filed November 20, 2009 have been fully considered but they are not persuasive.

Applicant states that in the present Office Action, that the Examiner has not produced any additional evidence in support of the rejections and that the Examiner has once again failed to provide sufficient evidence from the prior art to support the asserted rejections. Examiner disagrees. Claims 1-7, 10-15 and 42 are now rejected under 35

U.S.C. 103(a) as being unpatentable over Beane et al. and are *no* longer rejected under Section 102(b). As such, the current grounds of rejections were not presented to the BPAI and no decision was made with regards to the current 103(a) rejections.

Furthermore, the Examiner now fully admits that Beane et al. are silent with respect to a self-sealing mechanism disposed within the canal, and wherein the self-sealing mechanism is configured to allow an endoscope to enter the canal and make contact with the defogging material and to prevent the defogging material from spilling out of the canal. The current rejections rely on the newly provided teachings of Beane et al. As seen in Figs 6a-b, Beane et al. teach of an embodiment wherein a proximal region 612 includes a *distal seal* 620 and a *proximal seal* 622. Distal seal 620 has a generally conical shape, and is oriented to remove fluid from shaft 12 of laparoscope 10 as laparoscope 10 is moved in the direction of arrow G. Proximal seal 622 has a generally circular shape, and acts to remove fluid and debris from shaft 12 as it is moved in the direction of either arrow F or arrow G. Proximal seal 622 can be, e.g., an O-ring. Seals 620 and 622 can be made from, e.g., silicone or various thermal-plastic rubbers (see paragraphs 0089-0090). The seals would also effectively remove any excess cleaning liquid deposited on the lens from sponge 116, upon removal of the endoscope from canal 114. Thus, Beane et al. demonstrate that one skilled in the art at the time the invention was made, would have been motivated to position a self-sealing mechanism(s) at the entrance end of the canal and/or within the canal in the disclosed first embodiment to effectively remove any fluid or debris from the distal lens 14 of the endoscope as it is inserted into the canal 114.

In summary, the Examiner has NOT made substantially the same rejections against claims 1-15 and 42, as stated by the applicant. Newly presented teachings of Beane et al. provide motivation for the current rejections of claims 1-15 and 42 under 35 U.S.C. 103(a) as being unpatentable over Beane et al.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **MATTHEW J. KASZTEJNA** whose telephone number is (571)272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew J Kaszlejna/
Primary Examiner, Art Unit 3739

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